REMARKS

Claims 1-14 are pending in this present application. Claims 15-35 are withdrawn from consideration as being drawn to a non-elected invention. Reconsideration of the application is respectfully requested in view of the following responsive remarks.

In the Office Action of June 29, 2005, the following actions were taken:

(1) A restriction requirement under 35 U.S.C. 121 was formalized in writing;

(2) Claims 1-4, 6-10, and 12 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,808,583 (hereinafter "Kwasny"); and

(3) Claims 5, 11, 12, and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kwasny as applied to claims 1-4, 6-10, and 13.

It is respectfully submitted that the rejections of the presently pending claims be reconsidered and withdrawn and that all claims be allowed.

Statement Regarding Common Ownership or Obligation to Assign

As a preliminary matter, pursuant to MPEP 706(l)(2)(II), the Applicant hereby states that the presently pending application (Serial No. 10/783,610) was at the time the invention was made, owned by, or subject to an obligation of assignment to the same organization that owns U.S. Patent No. 6,808,583 by Kwasny et al., namely Hewlett-Packard Development Company.

Election and Restriction Requirement

The Examiner issued a restriction requirement pursuant to 35 U.S.C. 121. The Applicant confirms the election made on April 20, 2005 by Bradley Haymond in which claims 1-14 currently remain under consideration. The election corresponds to Group I as summarized by the Examiner in the Office Action of June 29, 2005.

Rejections under 35 U.S.C. § 102

Before discussing the rejections, it is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.,* 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), *cert. denied* 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.,* 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert denied,* 469 U.S. 851 (1984), "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has rejected claims 1-4, 6-10, and 12 as being anticipated by Kwasny under 35 U.S.C. 102(e). The Examiner asserts that Kwasny teaches each and every element of the rejected claims including a printed medium comprising a printed layer applied onto a plastic base, an adhesive layer applied onto the printed layer, a metal reflective layer, which the Examiner incorrectly states is applied to the adhesive layer, and a protective layer that is applied onto the metal reflective layer. Claims 1 and 14, the currently pending independent claims, share some characteristics with the teachings in Kwasny; however, there is one important element which Kwasny fails to teach. Specifically, Claims 1 and 14 both require "that at least a portion of said metallic layer is visible through the printable layer." This element is not taught or suggested in Kwasny. In fact, Kwasny teaches that between the adhesive layer and the metallic layer there is a "white matte layer." In other words, the metallic layer is not adhered directly to the adhesive, but rather it is adhered to a white matte layer which in turn is adhered to the adhesive. The white matte layer described in Kwasny prevents the metal layer from being visible through the printed layer as expressly required by the present claims. Therefore, as Kwasny fails to teach each and every element of the claims 1 and 14, and as claims 2-4, 6-10, and 12 depend from claim 1, it is respectfully requested that this rejection be withdrawn and the claims be allowed.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 5, 11, 12, and 14 under 35 U.S.C. 103(a) as being unpatentable over Kwasny as applied to claims 1-4, 6-10 and 13. The Applicant respectfully asserts that this rejection is improper under 35 U.S.C. 103(a), and more appropriately should be based on 35 U.S.C. 103(c)(1). Section 103(c)(1) reads as follows:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention, were at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

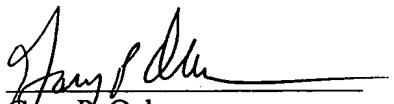
Kwasny is prior art under 35 U.S.C. § 102(e), and was used in a rejection under 35 U.S.C. § 103. The subject matter of the invention claimed in the present application was, at the time the invention was made, subject to an obligation to assign to Hewlett-Packard Development Company. See *Statement Regarding Common Ownership or Obligation to Assign*. As the present application is assigned to Hewlett-Packard Development Company (and was also under an obligation to assign to Hewlett-Packard Development Company at the time the present invention was made), Kwasny cannot preclude patentability under section 103. In light of this, it is respectfully requested that this rejection be withdrawn and that claims 5, 11, 12, and 14 be allowed independent of considerations of allowability with respect to the claims 1-4, 6-10, and 12 discussed above.

In view of the foregoing, Applicants believe that claims 1-14 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025

Dated this 28 day of September, 2005.

Respectfully submitted,



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